

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
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Kwasi ASARE, et al.	:	Confirmation Number: 3074
	:	
Application No.: 10/725,728	:	Group Art Unit: 2191
	:	
Filed: December 2, 2003	:	Examiner: A. Khatri
	:	
For: SCRIPT GENERATION ENGINE AND MAPPING SEMANTIC MODELS FOR TARGET PLATFORM	:	

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following remarks are submitted in response to the Notification of Non-Compliant Appeal Brief dated June 9, 2008 (hereinafter the Second Notice).

REMARKS

In response to Appellants' arguments in the Response to Notice of Non-Compliant Appeal Brief dated March 17, 2008, the following was stated on page 2 of the Second Notice:

The grouped claims 8 and 13 are not identical and therefore, the group is not allowed as it has led to the omission of reference to subject matter in the specification. Specifically, the grouping in the appellants claims has lead to, for example, the omission of a reference to the machine readable storage of Claim 13.

This analysis still fails to reconcile how the Examiner, on pages 6-8 of the Third Office Action, was able to group claims 8 and 13 together yet Appellants cannot do the same in the Second Appeal Brief. The Examiner did not separately refer to claims 8 and 13. Moreover, the Examiner did not even refer to the "machine readable storage."

The reason why the Examiner did not even refer to the "machine readable storage" is evident by a comment made by a different Examiner with regard to U.S. Patent Application No. 10/635,586. Specifically, on page 5 of the Third Office Action dated August 21, 2007, the Examiner, while arguing together independent claims 1 and 11 as a group,¹ the Examiner specifically stated that the machine readable storage is "inherent to any computer-implemented system." Thus, the Examiner did not even attempt to identify, within the applied prior art, a specific teaching corresponding to the machine readable storage.

Another reason why the Examiner, in the present Application, and the Examiner, in the U.S. Patent Application No. 10/635,586, did not separately refer to a machine readable storage is because the "machine readable storage" is found within the preamble of the claim and is not part

¹ Claims 1 and 11 of U.S. Patent Application 10/635,586 are respective directed to a "method" and "machine readable storage," which is the same as claims 8 and 13 of the present Application.

of the subject matter of the claim. Instead, the machine readable storage refers to the type of subject matter (e.g., claim 8 is directed to a method, whereas claim 13 is directed to a product). Thus, the omission of a "machine readable storage" is not an omission of the subject matter of the claim, as alleged in the Second Notice.

Appellants also note that the title of the section in the Appeal Brief is a "Summary of Claimed Subject Matter." What is being requested of Appellants, without any basis from the rules, is to essentially cut-and-paste the first full paragraph on page 3 of the Second Appeal Brief and replace the language "a method for ..." with "a machine readable storage for ..." while referring to claim 8 in the first paragraph and claim 13 in the second paragraph. Appellants are unclear as to how this summarizes the claimed subject matter when what is being requested is to create two nearly identical paragraphs. Thus, Appellants submit that the proposed change to the Summary of the Claimed Subject Matter section of the Second Appeal Brief actually defeats the purpose of summarizing the claimed subject matter.

Appellants also note that this allegation of a defective Appeal Brief is inconsistent with how other Appeal Briefs in the 2191 Group have been handled. For example, an Appeal Brief was filed on March 29, 2007, in U.S. Patent Application No. 10/725,612, in which claims 1 and 10 were summarized together (see page 2 of the Appeal Brief). In another example, an Appeal Brief was filed on October 24, 2007, in U.S. Patent Application No. 10/723,979, in which claims 1 and 15 and 10 and 20 were summarized together (see pages 2 and 3 of the Appeal Brief).

Thus, Appellants positions remains that the allegation that the Second Appeal Defective is without basis.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: June 29, 2008

Respectfully submitted,

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